

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 6, 2007. Claims 1-20 are pending in this Application. Claims 1-20 are rejected. Claims 1-5, 9, 12-15, and 20 have been amended. Applicant respectfully requests reconsideration and favorable action in this case in view of the following remarks.

Specification

Applicant appreciates the reminder on Page 2 of the Office Action of the proper language and format for an Abstract. Applicant has amended the Abstract accordingly. Favorable action is requested.

Section 112 Rejections

The Office Action rejects Claims 1-20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Office Action states: “there are no set standards for realization of human ‘intention’ and or ‘desire.’” *See* Office Action, Page 3. Although Applicant traverses, in order to expedite prosecution, the claims have been amended to recite “the hue of the color that was specified by the signal” to address these rejections. Favorable action is requested.

The Office Action rejects Claims 1-20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Office Action rejects Claim 1, lines 3, 7, and 12 as being indefinite for use of the phrases “operable to” and “capable of.” *See* Office Action, Page 4. Applicant respectfully traverses these rejections for the reasons described below.

The law is clear that “[t]here is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper.” *In re Swinehart*, 169 USPQ 226 (CCPA 1971); M.P.E.P. § 2173.05(g). If functional language defines one or more structural attributes of an element, then the

Examiner must give that language patentable weight.¹ A system element described as “operable to” perform or “capable of” certain functions covers operations that the element **is capable** of performing, and not just operations that the elements **may be capable** of performing. Applicant notes that the ordinary dictionary definition of “operable” is “practicable.” *See Webster’s II New College Dictionary* 227 (2001). The dictionary definition of “practicable” is “capable of being done.” *Id.* Thus, as stated above, elements following the term “operable to” or “capable of” in a particular claim element constitute operations that the claim element is capable of performing. Operations that a claim element is capable of performing are limitations, because the element is distinguished from the prior art that is incapable of performing the operations.

Applicant further notes that these phrases are commonly used in patent application claims, and are present in claims of numerous patents issued by the United States Patent and Trademark Office. For example, a search in the claims field of the United States Patents Database (as of April 18, 2007) produced well over 150,000 issued patents that include the phrase “operable to” in the claims. For at least these reasons, Claim 1 is allowable, as are all claims depending therefrom. Claims 9 and 18 are allowable for analogous reasons, as are all claims depending therefrom.

The Office Action also rejects Claim 1, lines 8 and 16 as being indefinite for use of the term “substantially.” Applicant respectfully traverses these rejections for the reasons described below.

The M.P.E.P. and the courts clearly condone the use of the term “substantially” in claims. *See* M.P.E.P. § 2173.05(b)(D) (citing *Andrew Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 U.S.P.Q.2d 2010 (Fed. Cir. 1988)). Moreover, claims that use the term “substantially” are definite if the Specification provides general guidelines for the term. *See* M.P.E.P. § 2173.05(b)(D) (citing *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975)).

¹ See e.g., MPEP §2173.05(g) (stating that “a chemical compound that is incapable of forming a dye,” “members adapted to be positioned,” and “portions. . . being resiliently dilatable whereby said housing may be slidably positioned” serve[d] to precisely define present structural attributes of interrelated component parts of the claims assembly.)

Applicant respectfully submits that the meaning and scope of Claim 1 would be clear to one of ordinary skill in the art at the time of invention in view of the general guidelines contained in the Specification at, for example, Page 13, lines 14-30, Figure 6, and Page 34 line 21 - Page 35 line 29. For at least these reasons, Claim 1 is allowable, as are all claims depending therefrom. Claims 9 and 18 are allowable for analogous reasons, as are all claims depending therefrom.

The Office Action also rejects Claim 1, lines 9 and 17 as being indefinite for use of the phrase “intended to be generated.” As described above, although Applicant traverses, in order to expedite prosecution, the claims have been amended to address these rejections. Reconsideration and favorable action are requested.

Section 101 Rejections

The Office Action rejects Claims 1-20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Specifically, the Office Action contends that “[a]s per claims 1, 9, and 18 applicant claims a ‘signal.’” *See* Office Action, Page 5. Applicant respectfully traverses these rejections for the reasons described below.

The patent laws define patentable subject matter as “any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto.” *See* 35 U.S.C. § 101. Applicant respectfully submits that Claims 1, 9, and 18 fall within these four categories of patentable subject matter. For example, Claim 1 is directed to a “control module for use in an image display system.” As another example, Claim 9 is directed to a “method of correcting a hue of a clipped pixel in an image display system.” As another example, Claim 18 is directed to a “method of adjusting a hue of a color associated with at least one clipped pixel to a hue of a color that was specified by a signal received by an image display system.” Thus, the mere fact that “a signal” is recited in Claims 1, 9, and 18 does not change the fact that Claims 1, 9, and 18 are directed to patentable subject matter as a whole.

Further, it is a well settled law that any process or apparatus that applies an equation or manipulates a signal to a new and useful end is patentable under § 101. *See NTP, Inc. v.*

Research in Motion, Ltd., 418 F.3d 1282, 1324 (Fed. Cir. 2005). For example, according to the Federal Circuit, “the transformation of electrocardiograph signals from a patient’s heartbeat by a machine through a series of mathematical calculations constitute[s] a practical application of an abstract idea (a mathematical algorithm, formula, or calculation) because it correspond[s] to a useful, concrete, or tangible thing—the condition of a patient’s heart. *State Street Bank & Trust Co. v. Signature Financial*, 149 F.3d 1368, 1373 (Fed. Cir. 1998). Moreover, “data, transformed by a machine through a series of mathematical calculations to produce a smooth waveform display on a rasterizer monitor, constitute[s] a practical application of an abstract idea (a mathematical algorithm, formula, or calculation) because it produced ‘a useful, concrete and tangible result’—the smooth waveform.” *Id.*

Applicant respectfully submits that a color adjustment for clipped pixels is at least as “useful, concrete, and tangible” as a smooth waveform or a patient’s heart condition. For at least the above reasons, Applicant respectfully requests reconsideration and allowance of Claims 1-20.

Section 102 Rejections

The Office Action rejects Claims 1-9 and 12-17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,453,067 issued to Morgan (“*Morgan*”). Applicant respectfully traverses these rejections for the reasons described below.

Claim 9, as amended, is allowable at least because the cited references do not teach or suggest “adjusting the hue of the color associated with the at least one clipped pixel and a saturation level associated with the color that was specified by the signal.” The Office Action contends that *Morgan* teaches adjusting a saturation level at Column 13, lines 8-17, but this is incorrect. In the cited portion, *Morgan* teaches “determining the saturation level of a pixel” and “calculating a gain level based on that saturation level.” *See Morgan*, Column 13, lines 13-14. However, calculating a gain level based on a saturation level does not constitute **adjusting a saturation level** associated with the color that was specified by the signal, as required by Claim 9.

For at least these reasons, Claim 9 is allowable, as are all claims depending therefrom. Claim 1 is allowable for analogous reasons. Claim 1 recites “a formatter coupled to the gain

module, the formatter operable to . . . adjust the hue of the color associated with the at least one clipped pixel and a saturation level associated with the color that was specified by the signal.” As discussed above, the gain system disclosed in *Morgan* does not teach or suggest a formatter operable to adjust a saturation level associated with the color that was specified by the signal. For at least these reasons, Claim 1 is allowable, as are all claims depending therefrom. Reconsideration and favorable action are requested.

Allowable Subject Matter

Applicant gratefully acknowledges the Examiner’s allowance of Claims 18-20. Applicant also notes with appreciation the indication that Claims 4-5 and 10-13 would be allowable if rewritten in independent form. Applicant has not rewritten Claims 4-5 and 10-13 in independent form because Applicant believes the independent claims are allowable, as amended, for the reasons discussed above. Favorable action is requested.

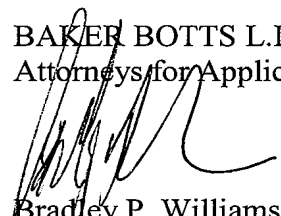
CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicant respectfully requests full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicant stands ready to conduct such a conference at the convenience of the Examiner.

Applicant believes no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 20-0668 of Texas Instruments Incorporated.

Respectfully submitted,

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